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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,268	08/29/2001	Helen Ann Holder	10016648-1	7255

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[REDACTED] EXAMINER

GONZALEZ, JULIO C

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

2834

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/941,268	HOLDER ET AL.
	Examiner	Art Unit
	Julio C. Gonzalez	2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 December 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 August 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the heat generating source driving a prime mover as disclosed in claim 3, the solar cell disclosed in claim 4, the wind turbine disclosed in claim 5, the flywheel apparatus disclosed in claim 13 must be shown or the feature(s) canceled from the claim(s).

No new matter should be entered. See MPEP 608.02 (d), (e).

Claims 2-5 and 13 disclose different types of power generator such as a proton exchange module cell, a heat generating source, a solar cell, a wind turbine and a flywheel. Such power devices require different implementation, circuitry, voltage requirements, etc. The drawings are not clear enough as to how such power devices will be able to be implemented “**within the housing**” of the power generation module as disclosed in claim 1. The power supply devices are well known, however, the power supply devices are not described as to how such power supply devices would be implemented in the applicant’s invention.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2-5, 7-10, 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
- The claims disclose using several means for producing electricity (e.g. solar cell, wind turbine, flywheel), but does not describe how the components producing electricity will be incorporated to the invention or what modifications to the invention have be done since using a flywheel or solar cells are two complete different means for producing electricity and incorporating such devices to an invention involves modification to an invention. Using a solar cells, wind turbines and a flywheel are completely different types of sources of energy that would require a power supply to have modifications. No structure is shown in the drawings nor any explanation is given in the specifications as to how such devices of energy can be incorporated with a power generation module.

A DC generator functions differently from the disclosed sources of energy in claims 2-4 (fuel cell, heat generating source and solar cells). Are the cells and the heat source part of a DC generator or are the cells and the heat source the DC generator? It may seem like if such cells and heat source are indeed the DC generator.

Also, how would a heat generating source be incorporated to the invention? What is producing electricity, the heat generating source or the retrofittable power supply? The specifications explain the used of cells for generating electricity, but does not provide as to how the components are incorporated. It seems like if the invention is a “black box” with an input (DC voltage) and an output (desk top computer).

More specifically, the specifications do not provide any description as to *how* the present invention would be implemented with the present invention. The power devices may be known, however, no physical description is found in the specifications as to the use of such power devices will be implemented or modified in order to fit “within the housing” as disclosed in claim 1 or what other parts may be needed for the wind generator or proton exchange power supply so that such power supplies be use with the present invention.

Also, during the interview in March 13, 2003, it was mentioned to the applicant's representative that a more concise explanation of the invention would be helpful and how it differentiates from a typical battery cell.

In order to advance prosecution in the merits, the Prior Art will be applied as best understood by the examiner.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 6, 7, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrier in view of Lee.

Carrier discloses a wireless power supply 14 having a housing with a form factor equal to that of a wired power supply, wherein the power supply 14 are rechargeable batteries and the retrofittable power supply replaces the wired power supply device (see figures 1, 2).

Although it is well known in the art to use DC/AC converters and a matter of design choice, another reference will be used to show that DC/AC are used in combination with batteries.

However, Carrier does not disclose explicitly using a DC/AC converter.

On the other hand, Lee discloses for the purpose of improving the power efficiency of DC powered system, a DC/AC converter 510 used in combination with batteries and a charging system (see figure 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design a wireless power supply as disclosed by Carrier and to modify the invention by using a DC/AC converter discloses for the purpose of improving the power efficiency of DC powered system as disclosed by Lee.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carrier and Lee as applied to claims 1 and 6 above, and further in view of Vaidyanathan.

The combined power supply discloses all of the limitations above. However, the combined power supply does not disclose the type of battery been used.

On the other hand, Vaidyanathan et al discloses for the purpose of delivering high amount of energy and permitting the battery to be hermetically sealed, a rechargeable proton fuel cell.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design the combined power supply as disclosed above and to modify the invention by using proton fuel cell for the purpose of delivering high amount of energy and permitting the battery to be hermetically sealed as disclosed by Vaidyanathan et al.

7. Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrier and Lee as applied to claims 1 and 6 above, and further in view of Hsu et al.

The combined power supply discloses all of the limitations above. However, the combined power supply does not disclose using a heat source.

On the other hand, Hsu et al discloses for the purpose of increasing the overall power efficiency in a gas turbine and electrochemical converter that a heat generating source in combination with fuel cells is used (see figure 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design the combined power supply as disclosed above and to modify by using a heat generating source for the purpose of increasing the

overall power efficiency in a gas turbine and electrochemical converter as disclosed by Hsu et al.

8. Claims 4, 5, 9, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrier and Lee as applied to claims 1 and 6 above, and further in view of ordinary skill in the art.

The combined power supply discloses all of the limitations above.

The combined power supply discloses the claimed invention except for using a wind generator, solar cell or a flywheel. It would have been an obvious matter of design choice to use such sources of energy, since applicant has not disclosed that the using a wind generator, solar cell or flywheel solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with fuel cells.

***Response to Arguments***

9. Applicant's arguments filed 12/12/02 have been fully considered but they are not persuasive.

According to the Merriam-Webster's Collegiate Dictionary, conventional means formed by agreement, something ordinary. Claim 1 discloses a housing

having a form factor equal to that of a conventional wired power supply device.

Carrier discloses a device 12 which has a housing wherein a conventional (formed by agreement) wired power supply 16 may also be used by another power supply device 14 which replaces the wired power supply device 16 (see figures 1 and 2).

With respect to the motor, anyone with ordinary skill in the art would know that a motor outputs torque, thus a motor is not a power supply device.

Also, from the claims it is not clearly defined what the claims means by “non-renewable”. According to the Merriam-Webster’s Collegiate Dictionary, renewable means, designating a commodity or resource, such as solar energy or firewood that is replaceable by new growth. Clearly the claims and specifications (e.g. claim 2, 3, 7 and 12) disclose fuel cells, rechargeable batteries and other means that may be replaceable, thus making the power generation module having renewable power. It is not well-defined in the claims how the present invention may be non-renewable. Even more, from the claims, it may seem like if the claim disclose a portable device (claims 1-5) since solar cell, converters, etc may be carried thus making them portable. By disclosing in claim 6 that the power supply may be in use in a non-portable device only renders intended use of the power supply and not a patentable feature.

10. In response to applicant's argument that the power supply is used in a non-portable device, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

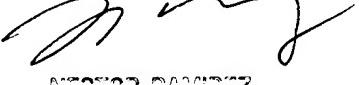
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julio C. Gonzalez whose telephone number is (703) 305-1563. The examiner can normally be reached on M-F (8AM-5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703) 308-1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
NESTOR RAMIREZ  
SPECIALIST IN COMPUTER TECHNOLOGY  
MAR 1 2003 2003

Jcg

January 29, 2003